

REMARKS/ARGUMENTS

Upon entry of the above amendment, claims 1-16 will have been canceled and claims 17-26 will have been submitted for consideration by the Examiner. In view of the above, Applicant respectfully requests reconsideration of the outstanding objection and rejections of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Official Action provided, and for the acknowledgment of Applicant's claim for priority under 35 U.S.C. § 119 and receipt of the certified copies of the priority documents, in the Official Action.

However, on the cover sheet of the outstanding Official Action, the Examiner indicated that certified copies of the priority documents have been received in Application No. 2001-026646. This is incorrect. The Application No. listed by the Examiner is actually the number of the Japanese document upon which Applicants rely for their claim for priority under 37 C.F.R. § 1.119. As noted on the previous line of the cover sheet, certified copies of the priority documents have been filed in the present application. The Examiner is respectfully requested to correct this matter.

Applicant also notes with appreciation the Examiner's acknowledgment of Applicant's Information Disclosure Statements filed in the present application on July 1, 2003 and January 5, 2005, by the return of the initialed and signed PTO-1449 Forms, and for consideration of the documents cited in the Information Disclosure Statements.

In the outstanding Official Action, the Examiner indicated that the Information Disclosure Statement filed on January 5, 2005 (not January 5, 2003), fails to comply

with the provisions of 37 C.F.R. § 1.97, 1.98 and MPEP section 609 and thus the published applications were not considered. The Examiner asserted that the identification of the two published applications was inadequate because leading zeros were omitted.

Applicant respectfully submits that the Examiner's nonconsideration of these documents is improper. Applicant first notes that each of these documents is merely a U.S. patent family member of other submitted and considered documents. Further, Applicant respectfully submits that there is no requirement for utilizing an 11-digit number to identify the published patent applications. In this regard, Applicant respectfully directs the Examiner's attention to MPEP section 609 III.A(1) which indicates that U.S. patent applications must be identified by an 8-digit application number. There is not, however, parallel requirement for published applications. Moreover, Applicant submits that one would immediately realize which documents are being identified in spite of the omission of a leading zero.

Accordingly, to complete the record in the present application, Applicant respectfully requests that the Examiner indicate consideration of the above-noted U.S. published applications in view of the fact that their identification was clear and that corresponding patent family applications have already been cited and considered. In this regard, Applicant notes that U.S. Patent Application Publication No. 2001/0014908 is a member of the patent family of U.S. Patent No. 6,256,622. Similarly, U.S. Patent Application Publication No. 2002/0133573 is a member of the family of European Patent Application Publication No. EP 1 001 584. These two documents have been

considered and accordingly it is submitted that the U.S. patent application publications corresponding to these documents also be considered by the Examiner.

Further, Applicant has also filed an Information Disclosure Statement in the present application on April 29, 2002. The Official Action of March 14, 2005 did not indicate the Examiner's consideration of the documents cited in this Information Disclosure Statement. Thus, Applicant respectfully requests that the Examiner send a copy of the signed PTO -1449 Form attached to the above-noted Information Disclosure Statement to Applicant with the next Official Action to confirm consideration of the documents cited therein.

Turning to the merits of the action, the Examiner has objected to claims 1, 5, 14, 15, 16 because of informalities. By the present amendment, Applicant has canceled claims 1, 5, 14, 15, and 16 without prejudice or disclaimer. Thus, Applicant respectfully submits that the Examiner's objections have been rendered moot.

The Examiner has rejected claims 3, 6-12, and 14-16 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. By the present amendment, Applicant has canceled claims 3, 6-12, and 14-16 without prejudice or disclaimer. Thus, Applicant respectfully submits that the rejection has been rendered moot.

The Examiner has rejected claim 9 under 35 U.S.C. § 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process. By the present amendment, Applicant has canceled

claims 8 and 9 without prejudice or disclaimer. Thus, Applicant respectfully submits that the rejection has been rendered moot.

In spite of the fact that claim 9 has been canceled, Applicant also submits that the Examiner's rejection thereof under 35 U.S.C. § 101 is inappropriate and improper. Claim 9 defines a user terminal "apparatus". It does not define a process. Moreover, the user terminal apparatus recited in claim 9 comprises an image information receiving section and an image information storing section. It is not clear on what basis the Examiner requires Applicant to set forth "steps" in a claim directed to an apparatus. Nevertheless, Applicant submits that claim 9 was in full compliance with 35 U.S.C. § 101 and that all the claims presently pending are also in full compliance therewith.

The Examiner has rejected claims 1, 4-5, 8-9, 12-13, and 16 under 35 U.S.C. § 102 (e) as being anticipated by KUMPF et al. (U.S. Patent No. 6,223,223). The Examiner has rejected claims 2, 6, 10, and 14 under 35 U.S.C. § 103 (a) as being unpatentable over KUMPF et al. (U.S. Patent No. 6,223,223) in view of DAVIS et al. (U.S. Patent No. 6,167,462). The Examiner has rejected claims 2, 6, 10, and 14 under 35 U.S.C. § 103 (a) as being unpatentable over KUMPF et al. (U.S. Patent No. 6,223,223) in view of UHLER et al. (U.S. Patent Publication No. 2001/0039587).

As noted above, Applicant has canceled claims 1-16, and has submitted new claims 17-26. Applicant respectfully traverses the above rejection based on the newly submitted claims 17-26 and will discuss the outstanding rejection with respect to these claims in the present application as will be set forth hereinbelow. The newly added claims merely clarify the subject matter recited in the canceled claims, but do not narrow the scope of the claims.

Applicant's claims 17-20 generally relate to a scanner apparatus which scans image data and comprises an interface configured to be connected to a terminal apparatus via a network. The scanner apparatus comprises a controller which receives, from the terminal apparatus, a search packet, the search packet being utilized to search for a scanner apparatus connectable to the terminal apparatus and transmits, to the terminal apparatus, a response to the search packet. The controller receives, from the terminal apparatus, terminal information, the terminal information including an IP address of the terminal apparatus, after the response to search packet is transmitted to the terminal apparatus, and transmits, to the terminal apparatus, the scanned image data, based on the IP address of the terminal apparatus included in the received terminal information. Claims 21-24 recite related terminal apparatuses. Claim 25 recites a related system. Claim 26 recites a related method.

In direct contrast, KUMPF et al. relate to a system in which a client is connected to a peripheral, e.g., a scanner (col.2, line 61), via a server. The client transmits, to the server, a command for opening a connection with the peripheral (col.3, lines 7-9). The server determines an availability of the peripheral (col.3, lines 20-22). When the scanner is available, the sever locks the peripheral so as to prevent other clients from using the peripheral (col.4, lines 8-11).

However, KUMPF et al. do not disclose a search packet which the scanner apparatus receives from the terminal apparatus and is utilized to search for a scanner apparatus connectable to the terminal apparatus, since KUMPF et al. merely disclose that client 12 sends a scan connection request to the server 10 and since KUMPF et al. do not contain any disclosure about the recited search packet.

KUMPF et al. also do not disclose terminal information which the scanner apparatus receives from the terminal apparatus and which includes an IP address of the terminal apparatus, since KUMPF et al. merely disclose that client 12 sends a scan connection request to the server 10 and since KUMPF et al. do not contain any disclosure about the recited terminal information.

Further, KUMPF et al. do not contain any disclosure about detailed operations of the scanner 16, since Fig.2A-2C are flow charts of the network server 10. Thus, KUMPF et al. do not disclose a scanner apparatus which receives, from the terminal apparatus, a search packet, the search packet being utilized to search for a scanner apparatus connectable to the terminal apparatus, transmits, to the terminal apparatus, a response to the search packet, receives, from the terminal apparatus, terminal information, the terminal information including an IP address of the terminal apparatus, after the response to the search packet is transmitted to the terminal apparatus, and transmits, to the terminal apparatus, the scanned image data, based on the IP address of the terminal apparatus included in the received terminal information.

On the other hand, the present invention recites a scanner apparatus which receives, from the terminal apparatus, a search packet, the search packet being utilized to search for a scanner apparatus connectable to the terminal apparatus, transmits, to the terminal apparatus, a response to the search packet, receives, from the terminal apparatus, terminal information, the terminal information including an IP address of the terminal apparatus, after the response to the search packet is transmitted to the terminal apparatus, and transmits, to the terminal apparatus, the scanned image data,

based on the IP address of the terminal apparatus included in the received terminal information. Thus, the pending claims are clearly distinguished over KUMPH et al.

Therefore, it is respectfully submitted that the features recited in Applicant's claims 16-26 are not disclosed in KUMPF et al. cited by the Examiner.

DAVIS et al. relate to a system in which, once a scanner is reserved, no other computer system can access the scanner. DAVIS et al. disclose a remote scanner configuration window that contains the password box 406 into which a user enters a password (col.3, lines 1-11, Fig.4).

However, DAVIS et al. do not disclose a search packet which the scanner apparatus receives from the terminal apparatus and is utilized to search for a scanner apparatus connectable to the terminal apparatus, since DAVIS et al. merely disclose that the client computer transmits, to the remote network server, a request for reserving the remote scanner and since DAVIS et al. do not contain any disclosure about the recited search packet. Thus, DAVIS et al. cannot overcome the shortcomings of KUMPF et al.

DAVIS et al. also do not disclose terminal information which the scanner apparatus receives from the terminal apparatus and includes an IP address of the terminal apparatus, since DAVIS et al. merely disclose that the client computer transmits, to the remote network server, a request for reserving the remote scanner and since DAVIS et al. do not contain any disclosure about the recited terminal information. Thus, again DAVIS et al. cannot overcome the shortcomings of KUMPF et al.

Further, Fig.10 of DAVIS et al. merely shows a general operation of the remote scanner. Thus, DAVIS et al. do not disclose a scanner apparatus which receives, from

the terminal apparatus, a search packet, the search packet being utilized to search for a scanner apparatus connectable to the terminal apparatus, transmits, to the terminal apparatus, a response to the search packet, receives, from the terminal apparatus, terminal information, the terminal information including an IP address of the terminal apparatus, after the response to the search packet is transmitted to the terminal apparatus, and transmits, to the terminal apparatus, the scanned image data, based on the IP address of the terminal apparatus included in the received terminal information. Thus, although DAVIS et al. do utilize a password, the disclosure thereof cannot overcome the shortcomings of KUMPF et al.

On the other hand, the present invention recites a scanner apparatus which receives, from the terminal apparatus, a search packet, the search packet being utilized to search for a scanner apparatus connectable to the terminal apparatus, transmits, to the terminal apparatus, a response to the search packet, receives, from the terminal apparatus, terminal information, the terminal information including an IP address of the terminal apparatus, after the response to the search packet is transmitted to the terminal apparatus, and transmits, to the terminal apparatus, the scanned image data, based on the IP address of the terminal apparatus included in the received terminal information. Thus, the pending claims are clearly distinguished over DAVIS et al.

Therefore, it is respectfully submitted that the features recited in Applicant's claims 16-26 are not disclosed in DAVIS et al. cited by the Examiner. The pending claims are also submitted to be patentable over the Examiner's proposed combination, since even the combination of KUMPF et al. and DAVIS et al. does not disclose the combination of the features recited in Applicant's claims 17-26. In this regard, Applicant



submits that the Examiner has not set forth a proper motivation for the proposed combination.

UHLER et al. relate to a method and apparatus for accessing a scanner on a network using HTTP. The client browser transmits, to the HTTP Scanner Server, a request for scanning the document in the scanner, and the HTTP Scanner Server determines whether the request is valid.

However, UHLER et al. do not disclose, and is not relied upon by the Examiner to disclose, a search packet which the scanner apparatus receives from the terminal apparatus and is utilized to search for a scanner apparatus connectable to the terminal apparatus, since UHLER et al. merely disclose that the client browser transmits, to the HTTP Scanner Server, a request for scanning the document in the scanner and since UHLER et al. do not contain any disclosure about the recited search packet. Thus, UHLER et al. cannot overcome the shortcomings of KUMPF et al.

UHLER et al. also do not disclose terminal information which the scanner apparatus receives from the terminal apparatus and includes an IP address of the terminal apparatus, since UHLER et al. merely disclose that the client browser transmits, to the HTTP Scanner Server, a request for scanning the document in the scanner and since UHLER et al. do not contain any disclosure about the recited terminal information. Thus, again UHLER et al. cannot overcome the shortcomings of KUMPF et al.

Further, although Fig.3 describes an operation regarding the scanner, Fig.3 of UHLER et al. merely shows a flow chart for accessing the scanner using HTTP. Thus, UHLER et al. do not disclose a scanner apparatus which receives, from the terminal

apparatus, a search packet, the search packet being utilized to search for a scanner apparatus connectable to the terminal apparatus, transmits, to the terminal apparatus, a response to the search packet, receives, from the terminal apparatus, terminal information, the terminal information including an IP address of the terminal apparatus, after the response to the search packet is transmitted to the terminal apparatus, and transmits, to the terminal apparatus, the scanned image data, based on the IP address of the terminal apparatus included in the received terminal information. Thus, the disclosure of UHLER et al. cannot overcome the shortcomings of KUMPF et al.

On the other hand, the present invention recites a scanner apparatus which receives, from the terminal apparatus, a search packet, the search packet being utilized to search for a scanner apparatus connectable to the terminal apparatus, transmits, to the terminal apparatus, a response to the search packet, receives, from the terminal apparatus, terminal information, the terminal information including an IP address of the terminal apparatus, after the response to the search packet is transmitted to the terminal apparatus, and transmits, to the terminal apparatus, the scanned image data, based on the IP address of the terminal apparatus included in the received terminal information. Thus, the pending claims are clearly distinguished over UHLER et al.

Therefore, it is respectfully submitted that the features recited in Applicant's claims 16-26 are not disclosed in UHLER et al. cited by the Examiner. Thus, pending claims are also submitted to be patentable over the Examiner's proposed combination, since even combination of KUMPF et al., DAVIS et al., and UHLER et al. does not disclose the combination of the features recited in Applicant's claims 17-26. In this

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regard, Applicant submits that the Examiner has not set forth a proper motivation for the proposed combination of KUMPH et al. and UHLER et al.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding objection and rejections, and requests an indication of the allowability of all the claims pending in the present application, in due course.


SUMMARY AND CONCLUSION

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has canceled the rejected claims and has submitted new claims for reconsideration by the Examiner. With respect to the pending claims, Applicant has pointed out the features thereof and has contrasted the features of the new claims with the disclosures of the applied references. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully requests an indication of the allowability of all the claims pending in the present application in due course.

The amendments to the claims which have been made in this amendment, which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,  
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